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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/045,301 | 10/26/2001 | Robert S. Bosko | 0006-0023 | 1272 |
| 7590 | 09/16/2004 | | EXAMINER | |
| Dennis Braswell 105 Soost Court Mobile, AL 36608 | | | MENON, KRISHNAN S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1723 | |

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

S.C.

| | | | |
|------------------------------|------------------|------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/045,301 | BOSKO, ROBERT S. | |
| | Examiner | Art Unit | |
| | Krishnan S Menon | 1723 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 August 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,6-8,11-15 and 18-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,6-8,11-15 and 18-31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Claims 1,6-8,11-15 and 18-31 are pending.

Claim Rejections - 35 USC § 112

1. Claims 1 and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 31 recite "... to allow conductive cooling ...", which does not have sufficient disclosure in the specification or claims as originally filed. Applicant cites page 9 lines 15-20 and page 14 lines 3-7 to support this amendment. The cited text is copied below.

Page 9:

15 to the R/O unit 36 for back-flushing of the R/O unit 36). In a preferred embodiment, the
16 reservoir 42 is located in close proximity to evaporator 32 or other cooling source
(such as,
17 without limitation, ice in the ice bin of an ice maker or dispenser), to cool (pre-chill) the
water
18 within the reservoir 32. Thus, with the system shown in FIGURE 3, a reservoir of
relatively cold
19 water (because of the reservoir's proximity to the cooling source) is available for use
by the host
20 system. This pre-chilling increases the efficiency of the host system's functions. Such
host

Page 14:

- 3 manufacturing, installation, and maintenance costs are significantly reduced. Also, lower**
- 4 maintenance cost result for all the pieces of equipment since they do not need to be cleaned of**
- 5 untreated water deposits, as is required today.**
- 6 Although the particular piece of equipment 102 shown in FIGURE 6 is an ice maker, the**
- 7 treated water source 104 may be included in connection with another host unit, rather than or in**

As is seen in the text, there is no disclosure of any conductive cooling. The "close proximity" language also does not imply conductive cooling, because heat conduction requires direct physical contact through a conductive medium, which is not disclosed.

2. Claims 1,6-8,11-15 and 18-31 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1,20 and 31 as amended recite the treated water source as sharing at least a part of a cabinet to have the treated water source integral with the water-using unit. However, sufficient disclosure could not be found in the specification or claims as originally filed to support this limitation in the amended claim. Claim 20 has the limitation 'said

separate unit does not share said cabinet', which also does not seem to be supported by the disclosure in the specification and claims as originally filed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 20-25, 27 and 31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by, or in the alternative, under 35 USC 103(a) as being obvious over Boulter (US 6,093,312).

Claim 20: Boulter (312) teaches a water-using unit (16 – fig 6) having a cabinet (fig 17-19), treated water source (8-fig 6), a host system (fig 24,26), control system (fig 24,26), and a separate remote unit coupled to the unit (ice-maker 2028, fig 24, and cooler system 2030-2033, fig 19). With regard to the user access areas and their being not presented as combined, a user access area would be inherent for any dispenser unit; any dispenser unit must logically have access (area) for someone to use it; and if dispenser units are located remote to one another, so would the corresponding user access areas be. The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784

(Fed. Cir. 1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). See also *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). With regard to "... the water source sharing at least part of the cabinet such that said treated water source is integral ...", the applicant has not shown any specific structure to show the water source as being integral with the water using unit that is different from that of the reference. (Making integral is not patentable: "...the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice" (*In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965)),. Moreover, there is no specific structure shown in the applicants' disclosure and drawings to differentiate the limitation the water source being integral with the water using unit, with that of the reference.). Re the remote system not sharing a cabinet, see fig 14, 17, 18 and 19 – a remote dispenser has a separate cabinet.

Boulter (312) teaches RO system and reservoir as in instant claims 21-23 (10, 2301, 8 – fig 24; col 6 lines 21-35), icemaker as in claim 25 (2300-fig 23).

Re claim 24: Boulter (312) teaches a water-using unit (fig 23), treated water source (2300), a host system (fig 24,26), control system (fig 24,26), and a separate remote unit coupled to the unit (water dispenser – ozonator 16,17-fig 7) as in instant claim 20, with treated water source comprising a reservoir (2300) as in claim 23 and further comprising a cooling source (2019) and said reservoir in cooling proximity to said cooling source (see fig 32) as in claim 24.

Re claim 27: Boulter (312) teaches a water-using unit (fig 23), treated water source (2300), a host system (fig 24,26), control system (fig 24,26), and a separate remote unit coupled to the unit (water dispenser – ozonator 16,17-fig 7) as in instant claim 20, host system comprises an ice-maker as in claim 25 (2019), and the treated water source is a reservoir (2300), ice maker has a cooling source, and the reservoir is in cooling proximity to the cooling source (see fig 32) as in claim 27.

Re claim 31, Boulter teaches a water-using unit (ice-maker 2028: fig 24); a water source integral with the unit (RO system 8-10; inside the kiosk: col 6 lines 62-63); a reservoir with the source (2301); a host system performing functions coupled to the source (see figures); a control system (see fig); a cooling source located in cooling proximity to the reservoir (see fig 32 – ice maker is a cooling source in cooling proximity to the reservoir 2301). With regard to ‘conductive cooling’, the reservoir 2301 is proximate to the ice maker 2019, and therefore, inherently would have conductive cooling, as in the applicant’s invention disclosed in page 9 lines 15-20 (In re Napier, etc. as above). Re the cabinet and the water source being integral with the water using unit, see claim 20 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1,8, 12, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boulter (US 6,093,312) in view of Voznick et al (US 5,256,279).

Boulter (312) teaches a water-using unit (fig 23) comprising a cabinet (Fig 17-19), treated water source (2300), a host system (fig 24,26), control system (fig 24,26), a separate remote unit coupled to the unit (water dispenser – ozonator 16,17-fig 7) and a cooling source located in cooling proximity to the reservoir (see fig 32 – ice maker is a cooling source in cooling proximity to the reservoir 2301) as in instant claim 1. With regard to ‘conductive cooling’, the reservoir 2301 is proximate to the ice maker 2019, and therefore, inherently would have conductive cooling, as in the applicant’s invention disclosed in page 9 lines 15-20 (*In re Napier, etc.* as above). Re the water source sharing the cabinet and being integral with the water using unit, the cabinet is being shared – see figures; being integral is not patentable: “...the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice” (*In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965)),. Moreover, there is no specific structure shown in the applicants’ disclosure and drawings to differentiate the limitation the water source being integral with the water using unit, with that of the reference.

Boulter does not teach a flexible reservoir for 2300 as in claim 1. Voznick teaches a reservoir having a bladder in which the reverse osmosis water is inside the bladder (fig 4,5; col 6 lines 19-34). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Voznick in the teaching of Boulter to have

the RO water inside the bladder for controlling the water stored in the bladder as taught by Voznick without having significant backpressure and prevent air-borne bacteria (see Voznick col 1 line 60 – col 2 line 17).

The cooling source comprises ice as in claim 12. Water not frozen in the icemaker is returned to the reservoir as in claim 14 (see fig 32).

Re claim 13, Boulter in view of Voznick does not specifically state a pulsating flow to the icemaker. However, Boulter (312) teaches a pump, Hoshizaki Model KM1600S (col 6 lines 66-67), which could pulse the water to the icemaker. It would be obvious to one of ordinary skill in the art at the time of invention to have pulsating flow to the icemaker due to such a pump as taught by Boulter (312).

3. Claims 26 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boulter (312) in view of Creddle Jr. (US 5,992,685).

Boulter (312) teaches all the limitations of claim 20. Claims 26 and 28-30 add further limitations as follows: beverage dispenser as in instant claims 26 and 28. Creddle (685) teaches a water-using unit with a beverage dispenser as in instant claims 26 and 28 (see figures and abstract). It would be obvious to one of ordinary skill in the art at the time of invention to have the Boulter R/O system coupled/connected to the beverage dispenser of Creddle (685) to have a filtered fluid before dispensing as taught by Creddle. (figure 2, R/O before dispensing)

4. Claims 15 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boulter (312) in view of Voznick (279) as in claim 1 above, and further in view of Creddle (685).

Instant claims add further limitations, which Boulter in view of Voznick does not teach but taught by Creddle as follows: Creddle (685) teaches a water-using unit with host system (see fig 1 and 12), the system comprises a beverage dispenser including a cooling source (abstract), as in instant claim 15; the system includes carbonator, supply of syrups and flavors as in instant claim 18 and 19 (abstract, fig 5-8). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Creddle in the teaching of Boulter in view of Voznick to have a beverage dispenser as taught by Creddle as an added feature to the water dispenser and to have the Boulter R/O system coupled/connected to the beverage dispenser of Creddle (685) to have a filtered fluid before dispensing as taught by Creddle. (figure 2, R/O before dispensing).

5. Claims 6,7,11 and 12 are rejected under 35 U.S.C. 103(a) as unpatentable over Boulter in view of Voznick as in claim 1 above and further in view of Blades (US 5,536,411).

Instant claims add further limitations not taught by Boulter in view of Voznick, but taught by Blades (411) as follows: condenser with the host system using RO reject water as in claim 6, inlet water as in instant claim 7 and cooling source comprising ice as in claim 12 (abstract, col 5 lines 45-67), the cooling source has an evaporator as in instant claim 11 (fig 4, col 5 lines 49-55). It would be obvious to one of ordinary skill in

the art at the time of invention to use the teachings of Blades in the teaching of Boulter in view of Voznick for energy recovery as taught by Blades in the 'Boulter in view of Voznick' system.

Response to Arguments

Applicant's arguments filed 10/20/03 and 9/22/03 have been fully considered but they are not persuasive.

In response to the argument that the Examiner has admitted in the last sentence of page 5 of the office action that the Applicants' specification disclose conductive cooling, the referenced line only meant for showing inherency, that is, if the applicant has conductive cooling due to proximity, so would the reference. The examiner would not go the lengths of showing lack of disclosure in the 35 USC 112 rejection, if the examiner believed that there was sufficient disclosure.

Arguments re the cabinet: please see the rejection.

Argument re the cooling proximity to the reservoir: cooling source is proximate to the reservoir. The reservoir not being flexible is addressed with a secondary ref.

Argument that Boulter show only reclaiming harvest overflow water and not cooling due to proximity: the rejection did not say that Boulter specifically states about cooling proximity; it is stated as being inherent, if the applicant can obtain cooling by proximity, so would the reference.

Re the motivation to combine the Voznick ref with the Boulter reference, see the rejection. Motivation is clearly stated with reference to the supporting text from the reference.

With re to the arguments about Credle ref: Credle ref does not need to show a reservoir as claimed in claim 1. Credle ref is used for its teaching of the beverage dispenser. Re the motivation, it is given in the rejection.

With re to the Blades ref: again, motivation is given in the rejection – energy recovery is a sufficient motivation for combining, and is suggested by the reference.

Arguments re the 102/103 rejection is based on the cabinet and the treated water source being integral with the water using unit – please see the rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Krishnan Menon
Patent Examiner


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